

THIS DISPOSITION
IS NOT CITABLE AS
PRECEDENT OF
THE TTAB

Mailed: October 10, 2002
Paper No. 14/16
CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re TRM Corporation

Serial Nos. 75/932,518 and 75/932,519

James H. Walters of Dellett and Walters for TRM Corporation.

Jill C. Alt, Trademark Examining Attorney, Law Office 114
(Margaret Le, Managing Attorney).

Before Cissel, Walters and Chapman, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

TRM Corporation has filed applications to register on
the Principal Register the marks IATMGLOBAL¹ and IATM² for
"automated teller machine services."

¹ Serial No. 75/932,518, in International Class 36, filed March 1, 2000,
based on an allegation of a bona fide intention to use the mark in
commerce.

² Serial No. 75/932,519, in International Class 36, filed March 1, 2000,
based on an allegation of a bona fide intention to use the mark in
commerce.

In each application, the Trademark Examining Attorney has issued a final refusal to register, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its services.

Applicant has appealed in each application. Both applicant and the Examining Attorney have filed briefs in each application, but no oral hearing was requested. Because the issues are the same in both appeals, and the records are essentially identical, we have considered the appeals in these two applications together and we issue a single opinion.

The Examining Attorney contends that "I" is commonly understood to mean "Internet"; that "ATM" is a commonly used and recognized acronym for the generic term "automated teller machine"; that, with respect to IATMGLOBAL, the term "global" means "worldwide"; and that the individual terms retain their ordinary meanings when combined in applicant's marks. The Examining Attorney contends that applicant's services are "Internet-enabled automatic teller machines that are available worldwide," and, thus, she concludes that both marks merely describe these services.

In support of her position, the Examining Attorney submitted the following definitions of the terms involved:

"global" - Of, relating to, or involving the entire earth; worldwide. *The American Heritage Dictionary of the English Language*, 3rd ed. 1992.

"ATM" - *abbreviation*. Automated teller machine. Automatic teller machine. *The American Heritage Dictionary of the English Language*, 3rd ed. 1992.

"ATM" - Automated teller machine.
www.acronymfinder.com, August 2, 2000.

"I" - Internet. www.acronymfinder.com, August 2, 2000.

"Internet" - 1. A large network made up of a number of smaller networks. 2. "The" Internet is made up of more than 100,000 interconnected networks in over 100 countries, comprised of commercial, academic and government networks. *The Computer Glossary*, 8th ed. 1998.

"Internet" - *noun*. A matrix of networks that connects computers around the world. *The American Heritage Dictionary of the English Language*, 3rd ed. 1992.

The Examining Attorney submitted a significant number of excerpts from various Internet websites and excerpts retrieved from the LEXIS/NEXIS database. A large number of these excerpts that use "iATM" or iATMglobal" refer to applicant, of which the following is an example:

iATMglobal.net, the e-commerce infrastructure subsidiary of TRM Corporation ..., announces that it has agreed to acquire Strategic Software Solutions Limited, a leading developer of custom Internet solutions for Automated Teller Machines (ATMs). Strategic Software Solutions and iATMglobal.net will build a Web-based distribution channel to deliver convenient access [to] e-commerce goods and services through the existing worldwide network of approximately one million ATMs. ... Strategic Software Solutions and NCR jointly market @tmLink, the only Internet-based ATM uploading and notification product for NCR-built ATMs. [www.kiosks.org, August 2, 2000.]

The following are examples of excerpts submitted by the Examining Attorney that discuss Internet banking and ATM services:

KeyCorp's online banking Web site, Key.com, has been ranked among the top five financial services sites on the Internet ...
The online service combines ATM functions with telebanking and other traditional services.
[*Dayton Daily News*, July 6, 2000.]

Wells is in the process of hooking to the Internet at least 800 of its ATMs in California and Arizona and plans to do the same throughout its territory. Consultants may debate the merits of Web-enabling ATMs, but several large banks, such as Bank of America, have announced plans to do it. [*The Charlotte Observer*, June 19, 2000.]

The Examining Attorney also submitted numerous excerpts showing use of the term ATM to mean "automated teller machine." The following are examples of excerpts that use "I" to refer to "Internet," sometimes as a trademark:

iPrint.com - "i" for Internet - went live in January 1997... [*Business Marketing*, August 1, 1999.]

But mostly Oracle8i is a statement of the way Oracle visualizes the future. The 'i' stands for Internet, and is a reminder of Oracle's belief that 'the Internet changes everything.'

The iMac also was built with networking in mind - in fact, the "i" stands for Internet. [*Industry Week*, December 21, 1998.]

Companies that have been successful in making a splash with the 20-something consumer market have used an IMC plan - in which the "I" stands for "Internet." [*Marketing News*, June 8, 1998.]

Internet service providers this year to offer large storage solutions called I:Drives. The I is for Internet. Subscribers would pay \$20 to \$30

per month to rent Internet space in 50MB to 100MB increments. [*Broadcast Engineering*, June 1998.]

Besides, I want to help shore up the embattled forces behind the "I" prefix, short for "Internet," of course. (InfoWorld, bucking the trend, has long preferred "I-commerce" to "e-commerce.") [*InfoWorld*, August 16, 1999.]

Domain names with an "I-" prefix - where the "I" stands for Internet, as in "I-notebooks" are hot now, along with the more familiar "e-" prefixes, Cuenca said. [*Computer Reseller News*, June 14, 1999.]

Applicant contends that the Examining Attorney has not made a prima facie case that applicant's marks are merely descriptive; and that the evidence submitted by the Examining Attorney actually supports applicant's position. Applicant alleges that third-party registrations demonstrate that "I" plus another term is registrable; that there is no evidence of third-party use of either of applicant's marks in a descriptive manner; that many of the articles submitted by the Examining Attorney refer to applicant, and the terms are used as applicant's marks; that, considered in their entirety, neither mark is merely descriptive, regardless of whether the individual terms comprising each mark may be descriptive; that the Examining Attorney has improperly considered the nature of applicant's services based on information other than the identification of services; and that applicant's mark has been registered in the United Kingdom and, therefore, it should be registrable by the USPTO.

Applicant submitted excerpts from its Internet website [www.iatmglobal.net, February 2000], including the following statements:

iATMglobal is an e-commerce infrastructure company building a software-driven distribution channel to furnish conveniently accessible e-commerce goods and services over the worldwide one million unit ATM network. We specialize in providing end-to-end e-commerce solutions for retailers, financial institutions, and non-bank deployers of ATMs by forming strategic relationships with select e-commerce companies interested in offering their goods and services to consumers via the ATM network.

When iATMglobal identified the need for ATMs to offer more revenue opportunities to the worldwide population of cardholders we realized that any solution had to be simple, scalable and profitable.

RAAP [Remote Access Application Protocol] allows existing Internet companies to offer their products and services on the ATM, in a manner consistent with ATM user expectations. And in so doing converts the ATM into a unique shop-front for the huge population of ATM users.

At the sharp end of our RAAP architecture is our ATM e-commerce Agent - our RAAP Agent. An extraordinary piece of well-worked software allowing seamless integration between the existing Cash Dispensing software on the ATM and our Internet Partner Companies.

Applicant also submitted a printout containing some information relative to its United Kingdom registration of IATMGLOBAL, although the goods or services are not listed; and copies of third-party registrations of marks with an "I" or "i" prefix followed by another word.

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or is intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used or intended to be used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

There is no question from this record that "ATM" is a commonly understood acronym for "automated teller machine," and that "global" is synonymous with "worldwide." Applicant does not appear to dispute either of these facts. Similarly, we find the evidence sufficient to establish that ATM services are available via the Internet; and that the

letter "I," in the context of ATM services, will be readily understood to be an acronym for "Internet."

Applicant's argument that the Examining Attorney improperly referred to materials outside of the recitation of services is not well taken. The Examining Attorney may refer to any appropriate resources to determine the nature of applicant's services. However, in determining whether a mark is merely descriptive, the Examining Attorney may not consider services that are not within the scope of the identified services in the application. Applicant's services are broadly identified in each application as "automated teller machine services," which terminology encompasses any medium for offering those services, including the Internet. Further, applicant's web site information indicates that its ATM services are intended to be offered via the Internet and/or that customers may have access to Internet-based retailers and other Internet-based services via ATMs that utilize applicant's services.

The combination of the individual terms into IATM and IATMGLOBAL does not change the meaning of the individual terms, does not create an incongruous meaning, nor has applicant suggested any other possible meaning for these terms when combined to form the marks herein. Therefore, IATM merely describes applicant's proposed Internet-related automated teller machine services; and IATMGLOBAL further

describes that these proposed services will have a worldwide scope.

We are not persuaded otherwise by applicant's arguments to the contrary. First, we note that applicant has not submitted a complete copy of its United Kingdom registration and, even if it had, U.S. trademark law is different from United Kingdom trademark law and the Board must determine the registrability of the marks herein by applying U.S. law. Second, the fact that third parties may have registered marks beginning with an "I" or "i" which may mean "Internet" is not dispositive of the appeals before us as each case must be decided on the basis of its particular facts.

"Third-party registrations simply are not conclusive on the question of descriptiveness, and a mark which is merely descriptive cannot be made registrable merely because other similar marks appear on the register." *See, In re Scholastic Testing Service, Inc.*, 196 USPQ 517, 519 (TTAB 1977).

Further, neither the fact that some of the evidence submitted refers to applicant, nor that applicant will or intends to be the first entity to use the terms herein in connection with such services, is dispositive where, as here, such terms unequivocally project merely descriptive connotations. *See In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953

(TTAB 1994), and cases cited therein; and *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973).

In conclusion, when used in connection with applicant's services, the terms IATM and IATMGLOBAL would immediately describe, without conjecture or speculation, a significant feature or function of applicant's services as discussed above. Nothing would require the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the terms IATM and IATMGLOBAL as they pertain to automated teller machine services.

Decision: The refusal under Section 2(e)(1) of the Act is affirmed in each application.